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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,634	12/01/2000	Makoto Miyazawa	Q61929	8039

7590

07/02/2002

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EXAMINER

MARKHAM, WESLEY D

ART UNIT

PAPER NUMBER

1762

14

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,634

Applicant(s)

MIYAZAWA, MAKOTO

Examiner

Wesley D Markham

Art Unit

1762

Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 4, 2002 has been entered.

Response to Amendment

2. Acknowledgement is made of applicant's amendment B, filed as paper #9 on March 4, 2002, in which Claims 6 – 10 were canceled without prejudice or disclaimer, Claims 1, 3, and 5 were amended, and Claims 11 – 12 were added. Claims 1 – 5 and 11 – 12 are currently pending in U.S. Application No. 09/701,634, and an Office Action on the merits follows.

Claim Objections

3. Claim 1 is objected to because of the following informalities: The phrase, "an obtaining step of receiving a spectacle frame information" in line 2 of the claim appears to contain a typographical error / improper grammar. The applicant is suggested to amend the phrase to read, "an obtaining step of receiving spectacle frame information". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The rejection of Claims 3 and 8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, set forth in paragraphs 4 – 5 of the final rejection (paper #8), is withdrawn in light of applicant's amendment B.
6. Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 2 (from which Claim 5 depends) recites the limitation "the first region" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination only, the limitation "the first region" has been interpreted to be equivalent to "the region" in order to correspond with independent Claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The rejection of Claims 1 – 10 under 35 U.S.C. 103(a) as being unpatentable over a number of combinations of Kato, Logan et al., Wood et al., Hoya Corp., Yasushi et al., and Komatsu et al., set forth in paragraphs 11 – 23 of the final rejection (paper #8), is withdrawn in light of applicant's amendment B and corresponding remarks.
9. Specifically, Claims 6 – 10 were canceled by the applicant per amendment B, and thus the rejection of these claims is moot. The applicant further argues that none of the references applied to Claim 1 (i.e., Kato, Logan et al., and Wood) teach the limitation of performing at least one step selected from the group consisting of a polishing step, a dyeing step, a hard coat formation step, and an anti-reflection coating formation step, after which the edging mark remains on the spectacle lens, as required by amended independent Claim 1. The examiner agrees that the aforementioned combination of references does not explicitly teach this limitation.
10. Claims 1 – 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035) in further view of Wood et al. (USPN 5,053,971), and in further view of either Blomberg et al. (USPN 6,242,065 B1) or the applicant's admitted prior art (AAPA).
11. Regarding independent Claim 1, the combination of Kato, Logan et al., and Wood et al. teaches all the limitations of the claim as set forth in paragraph 12 of the final rejection (paper #8) and below, except for a method wherein, after the marking step,

at least one step selected from the group consisting of a polishing step, a dyeing step, a hard coat formation step, and an anti-reflection coating formation step is performed, after which the edging mark remains on the spectacle lens. Specifically, while the combination of Kato, Logan et al., and Wood et al. suggests the applicant's claimed marking and edging steps (see paragraphs 12 – 13 of paper #8), the combination is silent as to intermediate lens processing steps that take place between the marking and edging steps. However, Blomberg et al. teach that, in the art of producing a spectacle lens (Col.1, lines 19 – 25), a normal process includes lens molding, hard coating, and antireflective coating prior to edging and placing the finished product into a lens frame (Col.8, lines 53 – 59). The AAPA also teaches that a known process for producing a spectacle lens includes the steps of dyeing, hard coat formation, and anti-reflection coating formation prior to edging the lens (see Figure 5, description in the "Background Art" section of the specification, and page 10, lines 13 – 15). It would have been obvious to one of ordinary skill in the art to deposit a hard coating and/or antireflective coating on the marked, unfinished lens of the combination of Kato, Logan et al., and Wood et al. prior to edging the lens with the reasonable expectation of (1) success, as both Blomberg et al. and the AAPA teach that that such a process was known in the art at the time of the applicant's invention, and (2) obtaining the benefits of depositing a hard coating and/or antireflective coating on a spectacle lens, such as providing a lens with superior abrasion resistance (Col.8, line 55 of Blomberg et al.) and/or reducing the amount of reflected light associated with the lens. As both Blomberg et al. and the

AAPA suggest performing these steps prior to lens edging (i.e., which is the step in which the edging marks / line of the prior art is cut-off), the edging mark would have remained on the spectacle lens after the hard coating and/or antireflective coating steps, as required by applicant's Claim 1.

12. Please note that amended independent Claim 1 also requires a step of forming the spectacle lens. As Kato teaches a method of processing a spectacle lens, the step of "forming the spectacle lens" claimed by the applicant is necessarily / inherently present (i.e., in order to perform process steps on a spectacle lens, the lens must first be "formed").
13. The combination of Kato, Logan et al., Wood et al., and either Blomberg et al. or the AAPA also teaches all the limitations of Claims 2 – 5 and 11 as set forth above in paragraphs 11 – 12 and below, including a method wherein / further comprising:
 - Claims 2 – 3 – The edging mark is an edging line that indicates the region of the lens remaining after an edging step (see paragraph 12 of paper #8, specifically the discussion of Logan et al.).
 - Claim 4 – The production information of the lens includes reference position marks indicating the vertical direction of the spectacle lens (Solution and Figure 1 of Kato).
 - Claim 5 – An edging step that cuts off the depicted production information (e.g., edging marks or lines) and is carried out after the polishing step, dyeing step, hard coat formation step, or anti-reflection coating formation step. Specifically, Kato teaches that the lens is cut (i.e., edged) to a

predetermined diameter so that the marks are not present at the time of lens delivery (Solution of Kato). This edging step is carried out after the aforementioned dyeing or coating steps (see paragraph 11 above).

- Claim 11 – The edging line is about 1 mm larger than and the same shape as the inner peripheral edge of an opening of the spectacle frame.

Specifically, Wood et al. suggest mapping the lens at a radius 0.02" (i.e., 0.5 mm) greater than the desired finished lens edge dimensions (which correspond to the size and shape of the eyeglass frame opening) (Col.7, lines 45 – 51, and Col.8, lines 1 – 5). 0.5 mm (as taught by Wood et al.) is "about 1 mm" as claimed by the applicant.

14. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035) in further view of Wood et al. (USPN 5,053,971), in further view of either Blomberg et al. (USPN 6,242,065 B1) or the applicant's admitted prior art (AAPA), and in further view of Komatsu et al. (JP 06-191159 A).
15. The combination of Kato, Logan et al., Wood et al., and either Blomberg et al. or the AAPA teaches all the limitations of Claim 12 as set forth above in paragraphs 11 – 13, except for a method wherein the edging mark is depicted by irradiating the spectacle lens with a laser beam. However, Komatsu et al. teach a method / apparatus that provides laser markings on the surface of a lens (Constitution). Komatsu et al. also teach that this apparatus performs marking operations simply,

and that the laser beams can be adjusted easily (Purpose). Therefore, it would have been obvious to one of ordinary skill in the art to utilize the laser marking method of Komatsu et al. as the marking method of the combination of Kato, Logan et al., Wood et al., and either Blomberg et al. or the AAPA with the reasonable expectation of successfully providing edging lines / markings on the spectacle lens simply and easily as taught by Komatsu et al.

Response to Arguments

16. Applicant's arguments with respect to Claims 1 – 5 and 11 – 12 have been considered but are moot in view of the new ground(s) of rejection presented above.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Application/Control Number: 09/701,634
Art Unit: 1762


Page 9

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham
Examiner
Art Unit 1762



WDM
June 27, 2002



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